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09/474,326

12/29/1999

THOMAS J. FOTH

E-977

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919 7590 06/15/2009

PITNEY BOWES INC.
35 WATERVIEW DRIVE
MSC 26-22
SHELTON, CT 06484-3000

EXAMINER

OBEID, MAMON A

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

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ELECTRONIC

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* THOMAS J. FOTH
9 and
10 BRIAN M. ROMANSKY
11

12
13 Appeal 2009-000331
14 Application 09/474,326
15 Technology Center 3600
16

17
18 Decided:¹ June 12, 2009
19

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21 Before HUBERT C. LORIN, ANTON W. FETTING, and
22 BIBHU R. MOHANTY, *Administrative Patent Judges*.

23
24 FETTING, *Administrative Patent Judge*.
25

26
27 DECISION ON APPEAL
28

¹ The two month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Thomas J. Foth and Brian M. Romansky (Appellants) seek review under 35 U.S.C. § 134 of a final rejection of claims 1-8, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

We AFFIRM-IN-PART.

The Appellants invented an improvement in online transactions by inputting into the computer a digital content file of the merchant. This digital content file includes a header with information related to purchasing a digital content product and the digital content product in encoded form. The computer reads the downloaded header and displays some of the information related to purchasing the digital content product while concurrently downloading the encoded digital content product into the computer. (Specification 4:Summary of the Invention).

An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below [bracketed matter and some paragraphing added].

1. A method for using a computer to facilitate a transaction between a merchant and a buyer, the method comprising the steps of:

[1] downloading into the computer

a digital content file of the merchant, the digital content file including

a header with information related to purchasing a digital content product and

the digital content product in encoded form; and

[2] using the computer for

1 reading the downloaded header and
2 displaying at least some of the information related to
3 purchasing the digital content product
4 while concurrently downloading the encoded digital
5 content product into the computer.

6 This appeal arises from the Examiner's Final Rejection, mailed May
7 25, 2005. The Appellants filed an Appeal Brief in support of the appeal on
8 October 24, 2005. An Examiner's Answer to the Appeal Brief was mailed
9 on April 19, 2007. A Reply Brief was filed on May 4, 2007.

10
11 PRIOR ART

12 The Examiner relies upon the following prior art:

13 Krishnan US 6,073,124 Jun. 6, 2000

14
15 REJECTION

16 Claims 1-8 stand rejected under 35 U.S.C. § 102(e) as anticipated by
17 Krishnan.

18
19 ISSUES

20 The issue of whether the Appellants have sustained their burden of
21 showing that the Examiner erred in rejecting claims 1-8 under 35 U.S.C. §
22 102(e) as anticipated by Krishnan turns on whether Krishnan describes
23 downloading concurrent with display of information, a broker computer
24 identifying and encrypting files at the content server, and the content being
25 dynamically encrypted during download.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Krishnan

01. Krishnan is directed to facilitating the purchase and delivery of electronic content using a secure digital commerce system, comprised of a plurality of modularized components, which communicate with each other to download, license, and potentially purchase a requested item of merchandise (Krishnan 4:11-19).

02. Krishnan's secure digital commerce system ("DCS") includes a DCS client and a DCS server. The DCS client includes client components, which are downloaded by a boot program onto a customer computer system in response to requesting an item of merchandise to be licensed or purchased. The downloaded client components include a secured (e.g., encrypted) content file that corresponds to the content of the requested item and licensing code that is automatically executed to ensure that the item of merchandise is properly licensed before a customer is permitted to operate it. The DCS server includes a content supplier server, which provides the DCS client components that are specific to the requested item, and a licensing and purchasing broker, which generates and returns a secure electronic licensing certificate in response to a request to license the requested item of merchandise. The generated electronic license certificate contains licensing parameters that dictate whether the merchandise is permitted to be

1 executed. Thus, once properly licensed, the downloaded client
2 components in conjunction with the electronic license certificate
3 permit a legitimate customer to execute (process) purchased
4 content in a manner that helps prevent illegitimate piracy
5 (Krishnan 4:21-44).

6 03. Krishnan's virtual store provides a set of icons, which each
7 describe an item of merchandise that can be purchased. Each icon
8 is typically linked to a server site on the network, which is
9 responsible for supplying the content of the item. When the user
10 selects one of the icons, the browser application, as a result of
11 processing the link, sends a request for the selected item to the
12 server site. The merchandise that can be licensed and distributed
13 online includes any type of digital or electronic, information or
14 data that can be transmitted using any means for communicating
15 and delivering such data over a network (Krishnan 6:57-7:10).

16 04. Krishnan describes what happens when the customer selects a
17 merchandise icon. The customer is queried whether to download
18 and store or download and execute the anchor file. When the user
19 indicates that the download file is to be executed, the extraction
20 code of the download file is executed, which causes the
21 component list to be extracted and the boot program executable to
22 be potentially decompressed, extracted and executed (Krishnan
23 15:63-16:3).

24 *Facts Related To The Level Of Skill In The Art*

25 05. Neither the Examiner nor the Appellants has addressed the level
26 of ordinary skill in the pertinent arts of systems analysis and

1 programming, digital product sales and delivery systems, and on
2 line sales systems. We will therefore consider the cited prior art
3 as representative of the level of ordinary skill in the art. *See*
4 *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001)
5 (“[T]he absence of specific findings on the level of skill in the art
6 does not give rise to reversible error ‘where the prior art itself
7 reflects an appropriate level and a need for testimony is not
8 shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys.*
9 *Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

11 PRINCIPLES OF LAW

12 *Claim Construction*

13 During examination of a patent application, pending claims are
14 given their broadest reasonable construction consistent with the
15 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
16 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

17 Limitations appearing in the specification but not recited in the claim
18 are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d
19 1364, 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
20 specification” without importing limitations from the specification into the
21 claims unnecessarily).

22 Although a patent applicant is entitled to be his or her own
23 lexicographer of patent claim terms, in *ex parte* prosecution it must be
24 within limits. *In re Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant
25 must do so by placing such definitions in the specification with sufficient
26 clarity to provide a person of ordinary skill in the art with clear and precise

1 notice of the meaning that is to be construed. *See also In re Paulsen*, 30
2 F.3d 1475, 1480 (Fed. Cir. 1994) (although an inventor is free to define the
3 specific terms used to describe the invention, this must be done with
4 reasonable clarity, deliberateness, and precision; where an inventor chooses
5 to give terms uncommon meanings, the inventor must set out any
6 uncommon definition in some manner within the patent disclosure so as to
7 give one of ordinary skill in the art notice of the change).

8
9 *Anticipation*

10 "A claim is anticipated only if each and every element as set forth in
11 the claim is found, either expressly or inherently described, in a single prior
12 art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d
13 628, 631 (Fed. Cir. 1987). "When a claim covers several structures or
14 compositions, either generically or as alternatives, the claim is deemed
15 anticipated if any of the structures or compositions within the scope of the
16 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
17 Cir. 2001). "The identical invention must be shown in as complete detail as
18 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
19 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
20 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
21 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

ANALYSIS

Claims 1-8 rejected under 35 U.S.C. § 102(e) as anticipated by Krishnan.

The Appellants argue claims 1-3 and 8 as a group. Accordingly, we select claim 8 as representative of the group. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

The Examiner found that Krishnan anticipated claim 1 (Answer 3-4: Claim Chart). The Appellants contend that Krishnan fails to describe the concurrent displaying of purchasing information with the downloading of encoded digital content (Br. 4: Last full ¶). The Appellants' contention is that there is no discussion in Krishnan of such concurrent downloading. Thus the issue is whether Krishnan's system does in fact perform the concurrent downloading as claimed.

We disagree with the Appellants. As the Examiner pointed out in the claim chart, Krishnan displays an icon that displays information regarding what is purchased concurrent with downloading the components of the purchased file. The contents of the download are encrypted (FF 01-04).

The Appellants next argue claims 4-6 using claim 4 as exemplary. Claim 4 is:

A method for using a computer by a broker to encrypt digital content product files of a merchant that are hosted at a merchant web site, the method comprising the steps of:
inputting into the computer an identification of the digital content product files designated for encryption together with the web site location of the digital content product files and information required to access the digital content product files; via the computer, connecting to the web site and accessing and encrypting the digital content product files designated for encryption; and storing the encrypted digital content product files at the web site.

1 The Appellants argue there is no discussion of a broker computer
2 identifying and encrypting files at the content server (Br. 6:Top ¶). We
3 agree with the Appellants. The Examiner cites the same portions as with
4 claim 1. These portions describe purchase of such files, not the loading of
5 those files. Claim 6 is a method claim, so it is not sufficient merely to show
6 that the same end result is achieved; the same steps must be performed for
7 anticipation. The Examiner has not shown such steps.

8 The Appellants next argue claim 7. Claim 7 is:

9 A method for distributing from a first computer digital content
10 products for purchase, the method comprising the steps of:
11 encrypting a first digital content product file;
12 statically storing the encrypted first digital content product file
13 at the first computer;
14 storing a second digital content product file in unencrypted
15 form at the first computer; and
16 inputting a request into the first computer for downloading from
17 the first computer to a second computer at least one of the
18 encrypted first digital content product file and the second digital
19 content product file;
20 wherein at times when the request is for the encrypted first
21 digital content product file downloading the encrypted first
22 digital content file to the second computer, and at times when
23 the request is for the second digital content product file
24 dynamically encrypting the second digital content product file
25 and sending the second digital content product file in encrypted
26 form to the second computer while maintaining the storing of
27 the second digital content product file in unencrypted form at
28 the first computer.

29 The Appellants argue Krishnan does not describe the content is
30 dynamically encrypted during download (Br. 6:Bottom ¶). We agree with
31 the Appellants. Again, the Examiner cites the same portions as with claim 1.
32 These portions describe purchase of such files, not the encrypting of those
33 files. Claim 7 is a method claim, so it is not sufficient merely to show that

1 the same end result is achieved; the same steps must be performed for
2 anticipation. The Examiner has not shown such steps.

3
4 **CONCLUSIONS OF LAW**

5 The Appellants have not sustained their burden of showing that the
6 Examiner erred in rejecting claims 1-3 and 8 under 35 U.S.C. § 102(e) as
7 anticipated by Krishnan.

8 The Appellants have sustained their burden of showing that the
9 Examiner erred in rejecting claims 4-7 under 35 U.S.C. § 102(e) as
10 anticipated by Krishnan.

11
12 **DECISION**

13 To summarize, our decision is as follows:

- 14 • The rejection of claims 1-3 and 8 under 35 U.S.C. § 102(e) as
15 anticipated by Krishnan is sustained.
- 16 • The rejection of claims 4-7 under 35 U.S.C. § 102(e) as anticipated by
17 Krishnan is not sustained.

18 No time period for taking any subsequent action in connection with
19 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

20
21 **AFFIRMED-IN-PART**
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23
24

Appeal 2009-000331
Application 09/474,326

1 hh

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5 35 WATERVIEW DRIVE
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